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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,134	09/08/2003	Valerie De La Poterie	230251US0	8666

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

NOTIFICATION DATE	DELIVERY MODE
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06/03/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/656,134	Applicant(s) DE LA POTERIE ET AL.	
	Examiner JYOTHSNA A. VENKAT	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-34 and 36-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-34 and 36-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged amendment and remarks filed on 5/12/08. Claim 56 has been canceled as per applicants' amendment dated 5/12/08. In view of the amendment, 102 (e) rejections are hereby withdrawn. Elected species is allowable. Claims are examined with respect to semi-crystalline polymer as the structuring agent.

Claim Rejections - 35 USC § 112

Claims 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 54 is unclear as to applicants' intent. Claim 54 depends on claim 43 and claim 43 depends on claim 31, which recites "wherein said composition is in the form of mascara".

Claim Rejections - 35 USC § 103

Claims 31-34 and 36-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,375,941 ('941) and 5,519,063 ('063).

Instant application is claiming composition comprising:

1. Fatty phase and the fatty phase has combination of specific compound and oil and the specific compound is drawn to semi-crystalline polymer and oil can be volatile or non volatile hydrocarbon oil or volatile or non volatile silicone oil.
2. Composition has no waxes
3. Composition has water and optionally hydrophilic organic solvents
4. Film forming polymer (claim 47 and the film forming polymer can be polyurethane or vinyl polymers or polyamides or polyesters or polyureas or cellulosic polymers)

5. Colorant (claims 50-51)

6. Cosmetic additive (claim 53)

Patent '941 teaches mascara product comprising polyurethane. Patent at col.3, ll 25-28 teaches the weight percent of the polymer and the weight percent of the film former claimed overlaps with the weight percent of polyurethane. Patent at col.1, ll 4-16 teaches compositions to mascara and at ll 17-21 teaches that the mascaras are commonly prepared as aqueous mascaras or anhydrous mascara. Anhydrous mascara is claimed in claim 43. Patent at col.2, ll 13-16 teaches wax free compositions. Patent at col.3, ll 28-35 teaches having water or hydrophilic solvents and the weight percent taught by patent is within the weight percent claimed. Patent at col.3 line 47 through col.4, line 36 teaches adding thickener to the compositions and the purpose of the thickener is for adjusting the viscosity. Patent at col.4, line 60 through col.5, line 2 teaches auxiliary film forming polymer and these polymers are claimed in the instant application as film forming polymers. Patent at col.4, ll 37-47 teaches claimed additives and this includes claimed colorants (dyestuffs, pigments and dyes) and oils. The difference between the patent and instant application is patent does not teach claimed semi-crystalline polymer and specific volatile or non volatile hydrocarbon oil or volatile or non volatile silicone oil.

Patent '063 teaches oily cosmetic compositions containing as a thickener association of two copolymers. This copolymer is the semi crystalline polymer claimed in the instant application. Patent at col.1, ll 10-15 teaches:

Numerous cosmetic compositions are known which are intended, principally, to be applied to the skin, lips, eye-lashes and hair, and which are provided in the form of oily solutions or in the form of emulsions. The preparation of these compositions generally requires thickening the oily phase principally to facilitate their application.

Patent at col.1, ll 50-59 teaches:

One of the advantages of the use of polymers for thickening cosmetic compositions is that they do not pass through the cutaneous barrier, so that there is no need to fear systemic toxicity.

Another advantage of the use of polymers is that it is possible to obtain significant thickening with a relatively small amount of the thickening agent.

Patent at col.2 and col.3, ll 1-24 teaches copolymer as a thickener and also the weight percent of the copolymer. Patent at col.3, ll 25-37 teaches oil phase and the weight percent of the fatty phase claimed is within the weight percent of the oily phase. Patent at col.4, ll 50-55 teaches weight percent of the components use in the compositions. This includes claimed water and water soluble alcohol (hydrophilic solvent). Patent at col.5, ll 7-54 describes the oils that can be used and this includes claimed volatile and non volatile hydrocarbon oils, volatile and non-volatile silicone oils. Patent at col.60-63 expressly suggests that the composition can be in "anhydrous compositions". Patent at col.6, ll 15 et seq teaches copolymer preparations. See table 1 for various copolymers. See example 7 drawn to "stearyl methacrylate/N vinyl pyrrolidone". All the copolymers are drawn to semi crystalline polymers. Patent under example F 8 teaches mascara formulations. Patent at col.5, ll 65-66 teaches anhydrous mascara compositions.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '941 and substitute the thickener of patent '063 for the thickener of patent '941 since both the thickeners are functional equivalents and add colorants suggested by patent '941 and add oils of patent '063 . One of ordinary skill in the art would be motivated to add the oils and polymeric thickener of patent '063 with the reasonable expectation of success that the compositions having the polymeric thickener and oils produce

gels that can be easily removed and they are not toxic and significant thickening effect is obtained with a relatively small amount of thickening agent. This is a prima facie case of obviousness.

With respect to limitations claimed in claims 32-34, 36-37 all these limitations are obtained using protocols described in the specification at pages 26-30 using specific equipments. PTO is not equipped to measure and therefore the claims are also prima facie obvious over the combination of patents '941 and '063.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1615